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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,794	06/03/2005	Takeshi Saika	234647	7402

23460 7590 12/28/2006  
LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER
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DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/526,794

Applicant(s)

SAIKA ET AL. ✓

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 03/07/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 11 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 11 and 22 recite "printed pattern with a color variation in the image". It is unclear as to what is meant by "color variation in the image". Does the applicant want to convey that the printed pattern is such that it causes variation in color? For the purpose of the examination, the examiner is interpreting claims 11 and 22 as any reference disclosing printed pattern on a substrate surface reads on the claims 11 and 22.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 9-10, 12, 13-17, 19-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-142797 (Machine translation provided by the examiner) in view of Lorincz (US 5, 812, 312).

With respect to claims 1, 2, 19, 12, 13-17, JP 2002-142797 discloses a pressure sensitive adhesive (PSA) sheet (0008) and a kit for microbial testing containing a water

solution and one or more sorts of color enhancing agents such as fluorescent staining agent (0011 and 0022). Further, the adhesive layer of PSA sheet comes in contact with a surface (test article surface) and collects microorganisms, which can then be detected or counted by making an optical image form using a microscope (0024). Additionally, the base material (substrate) of the adhesive sheet is formed of polyethylene-laminated paper (0014) and reads on substrate is a multilayer (claim 2). Additionally, JP 2002-142797 teaches that the smoothness (uneven difference) of the front face of the adhesive layer on which the microorganisms are collected is less than 20 micrometers or less. If the smoothness is 20 micrometers or less, then the counting of microorganisms will be easy (0016).

JP 2002-142797 is silent as to teaching of focusing marker is provided in the substrate, or in the adhesive layer, or on the surface (claims 1 and 19), focusing marker is an insoluble particle with an average particle size of 0.2 to 200  $\mu\text{m}$  (claims 3, 4, and 22), and particle size of 0.5 to 200  $\mu\text{m}$  (claims 9-10). However, Lorincz teaches a self-staining microscopic slide designed for immediate staining and viewing cells in biological fluids and tissue samples. Further the slide of Lorincz can include reference standards to facilitate microscope focusing and to allow measurements of cells and microorganisms (abstract). Lorincz teaches that it is beneficial to include size references such as fluorescent microspheres of known dimension (e.g. 1  $\mu\text{m}$ ) to the surface of the slide or the film such that they coincide with the field of focus of the specimen. According to Lorincz, this facilitates the focusing the microscope and provides an internal reference standard for size, which is preserved for

photomicrography or video image capture (column 4, lines 32-45). The microspheres of Lorincz reads on the focusing marker is an insoluble particle as claimed. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include microspheres of Lorincz in the adhesive sheet of JP 2002-142797, motivated by the desire to facilitate the focusing of the microscope such that microorganisms can be accurately detected and/or counted.

3. Claims 11, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-142797 (Machine translation provided by the examiner) in view of Lorincz (US 5, 812, 312) as applied to claims 1 and 19 above, and further in view of Herauf (US 5,085,937).

The invention of JP 2002-142797 is previously disclosed. As previously noted, JP 2002-142797 teaches that the smoothness (uneven difference) of the front face of the adhesive layer on which the microorganisms are collected is less than 20 micrometers or less. If the smoothness is 20 micrometers or less, then the counting of microorganisms will be easy (0016). JP 2002-142797 is silent as to teaching of focusing marker on the substrate surface is a printed pattern with a color variation in the image used for focusing. However, Herauf teaches a particulate monitoring tape to determine the amount of particulate matter, which has settled on the tape surface (abstract). Additionally, Harauf discloses of printing a grid pattern using black ink on the surface of the backing layer (substrate) (column 2, lines 39-42 and claim 4) such that the tape can be used to collect and analyze particulates under microscope (column 4, lines 23-28). The printed grid pattern of Harauf reads on the focusing marker on the

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substrate surface is a printed pattern with a color variation. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the printed grid pattern as taught by Harauf on the base sheet (substrate) of the adhesive sheet of 2002-142797, motivated by the desire to simplify the determination of the number of microorganisms on the adhesive sheet.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

APD



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